



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Stephanie Ayala et al.

Application No.: 09/545,288

Filed: April 7, 2000

For: METHOD FOR MAKING SMART
CARDS CAPABLE OF OPERATING
WITH AND WITHOUT CONTACT

) **MAIL STOP PETITION**
)
) Group Art Unit: 3729
)
) Examiner: MINH N TRINH
)
) Confirmation No.: 1602
)
)
)
)
)
)

**PETITION TO WITHDRAW RESTRICTION REQUIREMENT
PURSUANT TO 37 C.F.R. §1.144**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants hereby petition for a review and withdrawal of the requirement restricting claims 45 and 46 from the present application. This requirement was set forth in the Office Action dated April 27, 2006 (page 3). Applicants requested reconsideration and withdrawal of this requirement in the response filed July 27, 2006 (page 5). The requirement was repeated and made final in the Office Action dated October 13, 2006 (pages 2-3).

MPEP §803 sets forth two criteria for a proper restriction requirement. The first of these is that the inventions must be independent or distinct as claimed. The second criterion is that there would be serious burden on the Examiner if restriction is not required.

With respect to the first criterion, the restriction requirement of April 27, 2006 characterizes claims 45 and 46 as combination claims, and relies upon MPEP §806.05(c) as a basis for requiring restriction. As set forth in this section of the Manual, the claimed subject matter is distinct if it can be shown (A) that the

combination, as claimed, does not require the particulars of the subcombination as claimed, *and* (B) that the subcombination can be shown to have utility either by itself or in another *materially* different combination. These requirements are set forth in the conjunctive, i.e. both requirements must be met to show distinctness. The restriction does not meet both of these requirements.

Specifically, with respect to the second requirement that the subcombination be shown to have utility either by itself or in another materially different combination, the Office Action of April 27, 2006 asserts that the subcombination has separate utility "such as for connecting an end of the antenna or connection pad to an electronic module, etc." However, the "combination" of claims 45 and 46 has precisely the *same* utility. Specifically, claim 45 recites the step of fixing an integrated circuit chip into a cavity "such that conductive pads on the lower side of the chip... are in electrical contact with the connection pads of the antenna." Claim 46 recites that the integrated circuit chip "is disposed within a module..." Thus, as *claimed*, the subject matter of claims 45 and 46 has the precise utility that is identified in the Office Action in connection with the subcombination of examined claims 1, 2, 4, etc. Consequently, the subject matter of both sets of claims has the same mode of operation, function and effect.

Since the restriction does not meet both of the requirements for a showing of distinctness between combination and subcombination claims, it fails to comply with the first criterion for a proper restriction.

Second, the Office Action does not provide a supportable showing that a serious burden would be imposed on the Examiner if restriction is not required. In this regard, it should be noted that claim 45 is analogous to claim 4, which has been examined and found to be allowable. Appended to this Petition is a copy of claim 45

which has been annotated to identify corresponding recitations in claim 4, and its parent claim 1. A similar annotation is provided for claim 46.

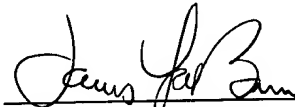
In responding to Applicants' request to reconsider the restriction requirement, the Office Action dated October 13, 2006 alleges that examination of the two sets of claims would present a burden "because the searches will not be coextensive." However, it fails to provide any support for this conclusory statement. For instance, it does not identify what additional field of search would be required for claims 45 and 46 that would not be appropriate for any of the claims that have already been examined. Given the close parallelism between the examined and restricted claims that is shown in the accompanying appendix, it is not apparent why any additional search effort would be required.

In summary, it is respectfully submitted that the Office Actions dated April 27 and October 13, 2006 do not meet either of the criteria for a proper restriction requirement. There is no showing of distinctness between the subcombination and combination claims, nor a showing of a serious burden that would be imposed if restriction is not required. Withdrawal of the restriction requirement, as applied to claims 45 and 46, and reinstatement of these claims in the application is respectfully submitted to be in order.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: January 16, 2007

By: 
James A. LaBarre
Registration No. 28,632

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

APPENDIX

Illustration of Relationship of Claims 45 and 46 to Other Pending Claims

45. A method for manufacturing smart cards, comprising the following steps:

producing, on a support sheet, an antenna with at least two turns, a pair of connection pads that are both disposed on a common side of said antenna turns **[Claim 1: "producing, on a support sheet, the antenna with at least two turns and a pair of connection pads that are both disposed on a common side of said antenna turns"]**, an insulator disposed across said turns **[Claim 1: "an insulating bridge disposed on a surface of said turns"]**, and a connective link on said insulator that connects the opposite side of said turns to one of said connection pads **[Claim 1: "connecting at least one of the ends of the antenna to a respective one of said connection pads by means of an insulating bridge..."]**;

laminating the support sheet to plastic foils to form a card body **[Claim 4: "assembling the support sheet to plastic foils to form a card body"]**;

machining a cavity in one face of the card body, to expose said connection pads **[Claim 4: "machining a cavity and connection recesses in an upper face of the card body, so that ... the connection recesses are situated above the connection pads of the antenna in order to expose said pads"]**; and

fixing an integrated circuit chip into the cavity such that conductive pads on the lower side of the chip, facing towards the inside of the cavity, are in electrical contact with the connection pads of the antenna **[Claim 4: "fixing an electronic module into the cavity, the module having on its lower side, facing towards the inside of the cavity, conductive pads in electrical contact with the connection pads of the antenna "]**.

46. The method of claim 45 wherein said integrated circuit chip is disposed within a module having conductors on one side for connecting said chip to said connection pads, and conductors on the opposite side that provide access to the smart card **[Claim 13: "the electronic module comprises an integrated circuit microchip and a double-sided printed circuit ..., the double-sided circuit comprising ... on one face a first set of conductive pads that form access contacts for the smart card, and on the other face a second set of conductive pads that are connected to the antenna"]**.